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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,891	07/05/2000	Joseph W. Luciano	LE9-00-044	5238

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LEXMARK INTERNATIONAL, INC.  
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EXAMINER

GARCIA, GABRIEL I

ART UNIT PAPER NUMBER

2624

DATE MAILED: 01/20/2004

*Handwritten number 17*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,841

Applicant(s)

Luciano et al

Examiner

H. Garcia

Art Unit

262v

-- The MAILING DATE of this communication appears on the coversheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/22/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-2, 6-17, and 21-26 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-26 is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1) ☐ Certified copies of the priority documents have been received.

2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892) 11/11/03, vol. 1

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

## Part III DETAILED ACTION

## Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>c</sup> of this title before the invention thereof by the applicant for patent.

2. Claims 1-2, 6-17, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al. (6,529,522).

With regard to claim 1, Ito et al. teaches a photoprinter configuration (e.g. figure 3), a digital camera (201) comprising a viewable display (307) and one or more selection mechanisms

(see fig. 3, items 301-305); and a photoprinter (202) capable of processing and printing digital files independent of an external

host device (see fig. 3, which depicts how the camera and printer

interact independent of an external host device) and connected to

the digital camera via a communication link (see fig. 3), the

photoprinter being operative to control the viewable display of

the digital camera (reads on col. 12, lines 5-9, col. 15, lines

38-60, col. 16-37, col. 17, lines 45-46, col. 18, lines 1-9, col.



With regard to claim 12, Ito et al. teaches to modify a printed rendition of digital photographs based on input to the selection mechanism (reads on col. 20, lines 59-67).

With regard to claim 13, the limitations of claim 13, are covered by the limitations of claims 1,2 and 6 above; and Ito et al. teaches a stand alone printer (see fig. 3), and to make a printer operate as a client to a host computer and to communicate data to client (see fig. 2).

With regard to claim 14, Ito et al. teaches wherein the standalone printer is a photoprinter (see fig. 3).

With regard to claim 15, Ito et al. teaches wherein the peripheral device is a digital camera (see fig. 3).

With regard to claim 16, Ito et al. teaches wherein the standalone printer comprises a means for receiving and sending data via the communication link (see figs. 2 and 3).

With regard to claim 17, Ito et al. teaches wherein the communication link is a universal serial bus (see col. 8, lines 19-37).

With regard to claims 21-23, the limitations of claims 21-23 are covered by the limitations of claims 13-17 above.

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**Conclusion**

3. Claims 24-26 are being allowed over the prior art of record. The prior art of record does not teach (in combination with all other features in the claims) a printer configuration wherein the stand alone printer comprises a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal bus device controller and universal serial bus host controller.

4. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. **THIS OFFICE ACTION IS MADE NON FINAL.**

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday thru Thursday from 7:30AM-6:00PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

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or faxed to:

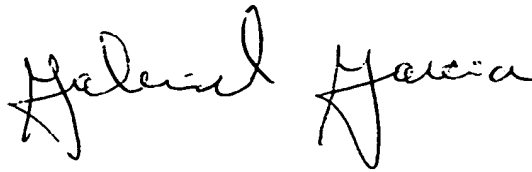
(703) 872-9314 (official or unofficial)

09/609,891

Art Unit 2624

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Gabriel I. Garcia  
Primary Examiner  
July 11, 2003

A handwritten signature in cursive script, reading "Gabriel Garcia". The signature is written in dark ink and is positioned above the printed name.

GABRIEL GARCIA  
PRIMARY EXAMINER